REMARKS

Claims 18-20 and 37-39 have been amended. Claims 11-40 are pending. It is believed that no new matter has been added.

35 U.S.C. § 112, second paragraph rejection

It is believed that the claims have been amended to sufficiently address the examiner's concerns. However, if not, it is requested that language which would be acceptable to the examiner be suggested with the next office action (see MPEP 707.07(j)).

35 U.S.C. § 103(a) rejection

Background

Claims 11-40 have been rejected by the examiner as being obvious over Dahms et al. (U.S. Patent 5,744,062) in view of Aronson et al. (U.S. Patent 4,606,913) and Kutz et al. (SÖFW-Journal, vol. 123, pp. 145-150, March 1997). The applicants request reconsideration for the following reasons:

The Dahms reference appears to be used by the examiner for its teachings of what can be considered to be a coemulsifier; i.e. the list of potential coemulsifiers cited in col. 5-6 appears to have been checked off against the four components of the applicants claim 11.

Before addressing the acknowledged differences by the examiner between Dahms et al. and the applicants claims, it is noted that Dahms et al. is unsuitable as a primary reference on other grounds. Namely, the invention of Dahms et al. is directed toward emulsifier blends comprising of a coemulsifier ***and*** a primary emulsifier (which is an acyl lactylate) - see both Dahms' "Summary of the Invention" and "Detailed Description of the Preferred Embodiments".

Dahms et al. does not contemplate that an emulsion could be stabilized in the absence of an acyl lactylate compound

The inclusion of additional coemulsifiers is almost an afterthought to their invention. This is borne out, for example, in col. 4, lines 23-33 which states:

> "In addition, by using the present method, which relies upon an empirical lactylate index described in detail hereafter, a stable o/w emulsion is achieved essentially independent of the new identity and concentration of the dispersed oil phase. ***The preparation of a stable o/w emulsion of desired viscosity also is independent of the identity of the coemulsifier, as long as the proper acyl lactylate, and amount of acyl lactylate, is used in conjunction with the***

> ***coemulsifier.*** The selection of a proper acyl lactylate is dependent on the desired viscosity of the new o/w emulsion..."

One of the differences the examiner cited between the Dahms et al. reference and the applicants claims is that the "...examiner takes the position that the optimal amount of the emulsifier components...would have been discovered by routine experiments." (see page 3, lines 10-12 of office action).

However, Dahms et al. does not suggest that there is any optimal amount for the coemulsifier component; only the amount of acyl lactylate needs to be optimized for the artisans desired purpose. Moreover, even if Dahms et al. recognized that emulsions could be stabilized merely by using coemulsifiers, they do not recognize that the four components claimed by the applicants would produce this effect. As mentioned previously, Dahms et al. list a number of coemulsifiers in col. 5-6. However, Dahms et al. themselves recognized the folly of trying to "pick and choose" the appropriate type and amount of coemulsifier to produce the desired effect in col. 2, lines 30-42:

> "However, the number of individual coemulsifiers and the number of primary emulsifiers is extremely large, and ***the potential combinations of coemulsifiers and primary emulsifiers is astronomical.....Until the present invention, formulators could rely only upon serendipity, trial and error, and prior experience*** in arriving at an emulsifier blend that would provide an o/w emulsion having the desired viscosity, stability, and feel."

As such, one of ordinary skill in the art would not select the four specific components as claimed by the applicants nor in the amounts claimed as cited in the dependent claims through "routine experimentation" as cited by the examiner.

Another difference cited by the examiner between Dahms et al. and the claimed invention is that "Dahms lacks an explicit teaching of method to stabilize the emulsion by incorporating the electrolytes into emulsion, and the selection of the specific emulsifiers in instant claims." (see page 4, lines 3-5 of office action) and cites Aronson et al. as a means to show obviousness for making the appropriate substitution.

It is well known that "The mere fact that references **can be combined** or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (see MPEP 2143.01 and *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). However in the present case, it is unclear that it can be taken for granted that the references can be combined.

Aronson et al. teaches the making of high internal phase emulsions (HIPEs) which are characterized by having a volume of the internal or dispersed phase which occupies a column more than about 74 to 75 percent of the total volume, i.e. a volume greater than is geometrically

possible for close packing of mono-dispersed spheres (see col. 1, lines 12-16). This is different than the low or medium internal phase ratios of the emulsions cited by Dahms et al. and claimed by the applicants.

Aronson et al. specifically states that "HIPE'S possess ***radically different properties*** from emulsions of the low or medium internal phase ratio types.". As such it is unclear that the electrolyte teaching of Aronson et al. could be combined into that of Dahms et al, i.e. one of ordinary skill in the art would not have had a reasonable expectation of success to make the substitution.

Even if it were to be conceded that Aronson et al. could be combined with Dahms et al. and that there would be reasonable expectation of success, the examiner is silent as to the motivation for making such a substitution. It does not appear that Aronson et al. or Dahms et al. offer the requisite motivation or suggestion for making the appropriate substitution.

From reading the examiner's application of the Kutz et al. reference, this appears to have been misinterpreted. The title translates to "Selection of O/W Emulsfier Stabilizers for Application in Skin-Care Products for Sensitive Skin". Table 1 represents an overview of some emulsifier stabilizers ("Übersicht der eingesetzen Emulgatoren"), i.e. this is not a emulsion composition nor a teaching to combine each of the listed ingredients. Basically, this teaches what was taught in col. 5-6 of Dahms et al. and as such the response provided above also applies here.

Therefore, when one of ordinary skill in the art views the applicants invention as a whole and considers the teachings of Dahms et al., Aronson et al. and Kutz et al. as a whole, one would not arrive at the applicants invention based on the cited references.

Closing

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, Washington, D.C. 20231, on the date indicated below:

Date: **9 October 2001**

By Howard C. Lee
Howard C. Lee